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REMARKS

Applicant acknowledges that claims 1-38 are pending in the application, and that the Office currently holds claims 1-38 as rejected.

In the Abstract of the Specification

The Office objects to the Abstract because it is too long, and requires that the Abstract be reduced to 150 words.

In response, Applicant herein amends the Abstract substantially as suggested by the Examiner. The amendment adds no new matter to the application.

35 USC §102(b)

Applicant submits that the standard for finding anticipation is one of strict identity. In other words, to anticipate under §102, a single prior art reference must disclose all the elements, or disclose their equivalents functioning in the same way as the claimed invention (*Shanklin Corp. v. Springfield Photo Mount Co.*, 187 USPQ 129, 133). According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983), cites omitted. It is not enough, however, that the reference disclose all the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “*arranged as in the claim.*” *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPO 481, 485 (Fed. Cir. 1984), cites omitted. Thus even if the prior art reference includes all the elements that are claimed, if the arrangement of the claimed elements is different from the arrangement of the prior art elements, anticipation will not be present.

Regarding the Schumacher '097 Reference

The Office holds claims 1-18 and 33-34 rejected under 35 USC §102(b) as being anticipated by Schumacher (the '097 reference). Applicant respectfully

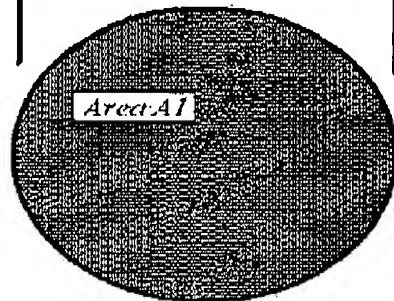
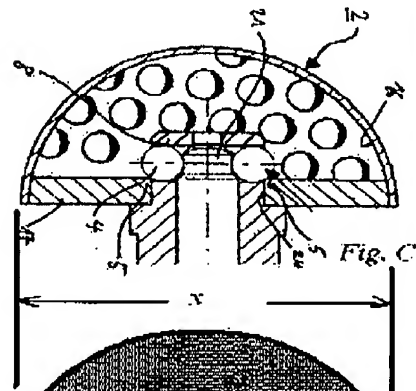
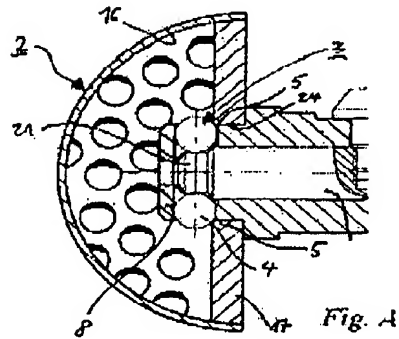
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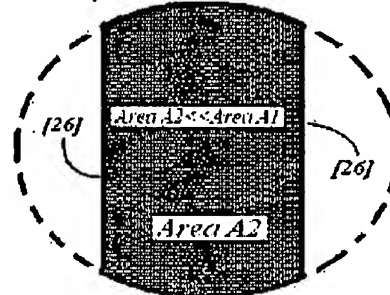
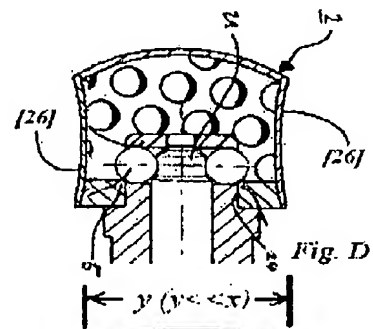
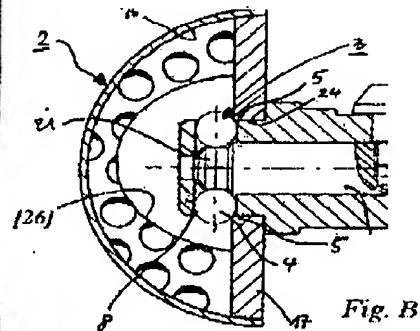
traverses this rejection, and submits that the Schumacher '097 reference does not disclose each element of the claimed invention "*arranged as in the claim*" as required by the Federal Circuit under *Lindermann*.

Regarding independent claims 1, 33 & 35, the Office alleges that the '097 reference discloses the "second curved portion generated about a center that is spaced apart from the axis" limitation of the instant claims, and points to figure 3 of Schumacher to support the allegation. However, this is incorrect – figure 3 of the '097 reference does not disclose this element of independent claims 1, 33 & 35, but rather circular cutouts in the support structure of a hemispherical reamer. The insertion profile is not all reduced thereby. Compare Figs. B & C and D & E below. Clearly this element (26), the second curved portion, is a part of the arrangement of elements of independent claim 1. See ref. no. 26 in Figs. 4-10, 12-15 and 17, and 27-29. Also see below, Figs. A, C & E showing the reamer of Schumacher and Figs. B, D & F showing the "second curved portion" element [26] of the instant claims, completely absent from the Schumacher reamer.

SCHUMACHER



INSTANT INVENTION



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Additionally this element (26) is inherent in independent claims 33 & 35, given the express recitation of the "pair of opposed base portions" of the reamer body of claims 33 & 35. However, in the interest of clarity and expediting prosecution, Applicant herein amends independent claims 33 & 35 to expressly recite the "second curved portion. . ." element. Because the '097 reference does not disclose the "second curved portion. . ." element of the instant claims, the Schumacher '097 reference does not disclose each element of the claimed invention "*arranged as in the claim*" as required by the Federal Circuit under *Lindermann*, the Office has failed to demonstrate *prima facie* anticipation over the Schumacher reference.

Regarding independent claim 37, *inter alia*, the element of: "an alignment structure having at least two bars. . . spaced from one another. . . connected together by a cross-member in an H-shape" is clearly recited in the claim. Additionally, as noted by the Office, the CCPA in *Kalman* required that something in the reference read on the claims under attack. More specifically, later the Federal Circuit in *W.L. Gore & Assocs.* stated: "[a]nticipation requires the disclosure in a single prior art reference of **each element** of the claim under consideration." Emphasis added. Additionally, it is not enough that the reference disclose all the claimed elements in isolation (as might be interpreted by the Office's citation of *Kalman*). Rather, as stated by the Federal Circuit in *Lindermann*, the prior art reference must disclose each element of the claimed invention "*arranged as in the claim*." All cites are given above. The "alignment structure. . ." element of independent claim 37 is not disclosed in the Schumacher '097 reference, nor is its equivalent. Therefore, the Schumacher '097 reference does not disclose each element of the claimed invention "*arranged as in the claim*" as required by the Federal Circuit under *Lindermann*, the Office has failed to demonstrate *prima facie* anticipation over the Schumacher reference.

Regarding the Weigand '572 Patent

The Office holds claims 1-38 rejected under 35 USC §102(b) as being anticipated by Weigand *et al* (the '572 patent). Applicant respectfully traverses this rejection, and submits that the Weigand '572 patent does not disclose each element of

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the claimed invention “*arranged as in the claim*” as required by the Federal Circuit under *Lindermann*.

Applicant submits the same remarks over the ‘572 patent as above regarding independent claims 1, 33 & 35. The Office alleges that the ‘572 patent discloses the “second curved portion generated about a center that is spaced apart from the axis” limitation of the instant claims, and points to figures 11, 14 and 17 of Weigand to support the allegation. However, this is incorrect - the ‘572 patent does not disclose element of independent claims 1, 33 & 35. Clearly this element is a part of the arrangement of elements of independent claim 1. Additionally this element is inherent in independent claims 33 & 35, given the express recitation of the “pair of opposed base portions” of the reamer body of claims 33 & 35. However, as noted above, Applicant herein amends independent claims 33 & 35 to expressly recite the “second curved portion. . .” element. Because the ‘572 patent does not disclose the “second curved portion. . .” element of the instant claims, Weigand does not disclose each element of the claimed invention “*arranged as in the claim*” as required by the Federal Circuit under *Lindermann*, the Office has failed to demonstrate *prima facie* anticipation over the Weigand patent.

Regarding independent claim 37, *inter alia*, the element of: “an alignment structure having at least two bars. . . spaced from one another. . . connected together by a cross-member in an H-shape” is clearly recited in the claim. Additionally, as noted by the Office, the CCPA in *Kalman* required that something in the reference read on the claims under attack. More specifically, later the Federal Circuit in *W.L. Gore & Assoc.* stated: “[a]nticipation requires the disclosure in a single prior art reference of **each element** of the claim under consideration.” Emphasis added. Additionally, it is not enough that the reference disclose all the claimed elements in isolation (as might be interpreted by the Office’s citation of *Kalman*). Rather, as stated by the Federal Circuit in *Lindermann*, the prior art reference must disclose each element of the claimed invention “*arranged as in the claim*.” All cites are given above. The “alignment structure. . .” element of independent claim 37 is not disclosed in the Weigand ‘572 patent, nor is its equivalent. Therefore, the Weigand ‘572 patent

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does not disclose each element of the claimed invention "*arranged as in the claim*" as required by the Federal Circuit under *Lindermann*, the Office has failed to demonstrate *prima facie* anticipation over the Weigand patent.

Regarding Dependent Claims, Rejection Moot

Applicant appreciates the Examiner's effort and diligence in searching the art and formulating the grounds for supporting these rejections. However, in view of the Office's failure to establish a *prima facie* case of anticipation over independent claims 1, 18, 33, 35 & 37 the §102(b) rejections of dependent claims are moot.

Applicant believes that the above amendments and remarks are fully responsive to the Office Action mailed 5 June 2007. Applicant respectfully requests reconsideration and removal of all objections and rejections of claims, and that, in view of the above amendments and remarks, the application is now in condition for allowance. Applicant respectfully requests the Examiner to contact the undersigned to timely resolve any minor issues that may remain in the application. Alternatively, Applicant invites the Examiner to suggest alternative claim language for Applicant's consideration, in order to facilitate timely prosecution of this application.

§ § §

Conclusion

Applicant has made a diligent effort to advance the prosecution of this application by amending claims 1, 25, 27-29, 33 and 35, and by pointing out herein with particularity how the claims now presented are patentably distinct from the prior art of record. Therefore, Applicant respectfully submits that the claims, as amended, are now in condition for allowance. No new matter has been entered by this amendment. Any limitations to the claims are made solely for the purpose of

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expediting the prosecution of the application and, unless otherwise expressly stated, are not made to narrow, vis-à-vis the prior art, the scope of protection which any subsequently issuing patent might afford. Again, if the Examiner has further questions, he is invited to contact the undersigned at phone 011-4171-230-1000, fax at 011-4171-230-1001 (Switzerland is 6 hours ahead of Eastern Std Time), or e-mail at moetteli@patentinfo.net.

Applicant petitions the Commissioner for an Extension of Time under 37 CFR §1.136 for a period of THREE months and the Undersigned authorizes the Commissioner to charge any fee or credit any overpayment of any fee under 37 CFR §1.16 and §1.17 which may be required in this application to the deposit account of MOETTELI & ASSOCIES SARL, no. 50-2621.

Respectfully submitted,


/s/John moetteli/

John Moetteli
Registration No. 35,289
202-204-2222

Dec 2, 2007
Date

Enclosure: none